

United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 059643.00364
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/761,584
	Filed: January 22, 2004
	First Named Inventor: Jukka TUOMI
	Art Unit: 2141
	Examiner: Brian J. Gillis

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

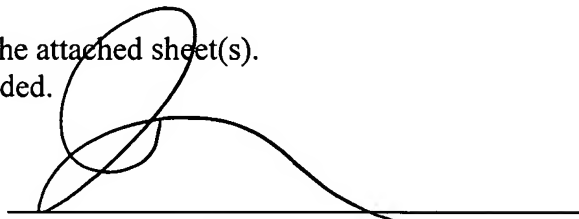
Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 47,818

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


Signature

David D. Nelson
Typed or printed name

703-720-7876
Telephone number

August 13, 2008
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jukka TUOMI

Application No.: 10/761,584

Filed: January 22, 2004

For: COMMUNICATION SYSTEM

Confirmation No.: 4261

Art Unit: 2141

Examiner: Brian J. Gillis

Attorney Dkt. No.: 059643.00364

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

August 13, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicant hereby submits this Pre-Appeal Brief Request for Review of the final rejections of claims 1-3, 5-11 and 13-26 in the above identified application. Pending claims 1-3, 5-11 and 13-26 were finally rejected in the Office Action dated May 13, 2008. Applicant filed a Response to the Final Office Action on June 12, 2008, and the Office issued an Advisory Action dated June 20, 2008 maintaining the final rejections of claims 1-3, 5-11 and 13-26. Applicant hereby appeals these rejections and submit this Pre-Appeal Brief Request for Review.

The Office Action rejected claims 1-3, 5, 11, 13, 14, 16-21, and 26 under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,785,704 (McCanne), and this rejection was maintained in the Advisory Action. Due to clear legal and factual errors, as will be discussed, this rejection should be withdrawn in view of the following explanations.

McCanne generally describes a technique for improving the efficiency of content distribution by configuring a DNS server such that it can map a name of a name-to-address translation request to a selected one of a plurality of addresses from which the desired content is available, wherein the selection is made on the basis of one or more factors such as configured policy, server load measurements and network path measurements. However, McCanne contains no disclosure in the sections cited in the Office Action that are relevant to the recited embodiments of the described in the present application related to resolving via a mobile operator access controller a DNS query from a UE attached to a third party access network, such

as a wireless Internet service provider, even (i) when the UE is not authorized by the mobile operator or (ii) when there is no server address for the queried domain name, such as when the domain name that is the subject of the DNS query, within the mobile operator domain.

For example, the Office Action cited to McCanne at col. 31, lines 10 to 23 as allegedly disclosing the recitation of resolving the domain name information for a domain name outside the (e.g. mobile operator) domain in the event that the UE is not authorized or there is no specified server address for the queried domain name within the (e.g. mobile operator) domain. Applicants respectfully urge that, at best, the technical interpretation of this citation in Office Action appears to be technically and factually inaccurate because this section of McCanne does not disclose resolving a domain name within or outside a domain according to whether the client is authorized. For example, Applicants note that this section of McCanne contains no disclosure related to a server, such as the APAR-DNS discussed in McCanne, resolving the domain name information for this domain name within this domain, in response to a determination that this user equipment is authorized and there is specified for this domain name a server address within this domain or accessible via this domain, and that server resolving the domain name information for this domain name outside this domain in response to a determination that the user equipment is not authorized and/or that there is no specified server address for this domain name within this domain or accessible via this domain, as recited in each of the independent claims. Instead, this section of McCanne teaches only returning the same IP address (i.e., resolving the queried domain name within the same domain) regardless of whether the client is authorized or not, by specifying a different port number according to whether or not the client is authorized.

Referring to claim 1, Applicants respectfully urge that McCanne does not disclose the access controller provided in embodiments of the present application. As described below, McCanne does not control resolving of domain name information for both server addresses within a network or accessible via said network and also server addresses that are not within a network or accessible via a network, as recited in claim 1. Furthermore, claim 1 recites that the access controller is configured to, in response to a determination that this user equipment is authorized and there is specified for this domain name a server address within this domain or accessible via this domain, resolve domain name information for this domain name within this domain. Conversely, in response to a determination that the user equipment is not authorized and/or that there is no specified server address for this domain name within this domain or

accessible via this domain, the access controller is configured to resolve the domain name information for this domain name outside this domain. For example, as disclosed in the present application, the access controller 16 described at paragraphs [0032] to [0047] is configured to resolve domain name, whether or not the user equipment is authorized, and consequently, whether the specified server address for this domain name within this domain or, and also on the written information provided. See also, the access controller AC (16) in FIGS. 2b, 3a and 4a and the associated text.

For these and other reasons, McCanne does not disclose each and every of claim 1, and this rejection of claim 1 should be withdrawn. Also, independent claims 13, 17, and 18, although separately rejected and different in scope, contain similar recitation related to an access controller that is configured to resolve domain names whether or not the user device is authorized are, thus, similarly allowable of McCanne. Claims 3, 5, 11, 14, 16, 19-21, and 26 are likewise allowable for at least the reason of depending from an allowable independent claim. Thus, due to the clear legal and factual errors, withdrawal of this rejection, and reconsideration and allowance of claims 1-3, 5, 11, 13, 14, 16-21, and 26 are respectfully requested.

The Office Action rejected claims 6, 7, 22, and 23 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over McCanne in view of PCT Published Patent Application No. WO 2000/64104 (Roos), and this rejection was maintained in the Advisory Action. Due to clear legal and factual errors, as will be discussed, this rejection should be withdrawn in view of the following explanations. According to the Office Action, McCanne discloses all elements of the claims except for an authorizing server function, and to address this deficiency in McCanne, the Office Action cites to Roos. However, the combination of McCanne and Roos fails to disclose each and every limitation of these claims as required for a proper rejection under 35 USC §103(a).

Referring to claim 1, Roos does not disclose or suggest an access controller provided in embodiments of the present application. For example, Roos does not disclose controlling the resolving of domain name information for both server addresses within a network or accessible via said network and also server addresses that are not within a network or accessible via a network, as recited in claim 1.

Instead, Roos relates to establishing a data connection with a mobile terminal in a digital mobile network, at which the mobile network is in connection with data processing resources in

a local network. The establishing of the data connection includes allocation of a local network address to the mobile terminal, allocation of a unique network address to the mobile terminal, determination of a relation between the local network address and the unique network address, reception of a request for a data connection to the unique network address, establishing of a data connection to the unique network address, at which the set up is made depending on the relation between the local and the unique network address. Nevertheless, Roos cannot be interpreted as disclosing the controlling of a resolution of domain name information for both server addresses within a network or accessible via said network and also server addresses that are not within a network or accessible via a network, as recited in claim 1.

For these and other reasons, the combination of McCanne and Roos does not disclose each and every limitation of the independent claims, such as claim 1. Thus, claims 6, 7, 22, and 23 are allowable over McCanne and Roos for at least the reason of depending from allowable claims 1 or 17. Due to these clear legal and factual errors, withdrawal of this rejection under 35 U.S.C. §103(a), and reconsideration and allowance of claims 6, 7, 22, and 23 are thus respectfully requested.

The Office Action further rejected claims 8-10, 15, 24, and 25 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over McCanne in view of PCT Published Patent Application No. WO 2002/47415 (Westman) and this rejection was maintained in the Advisory Action. Due to clear legal and factual errors, as will be discussed, this rejection should be withdrawn in view of the following explanations. According to the Office Action, McCanne discloses all elements of the base independent claims, and Westman discloses the limitations of the dependent claims. However, this combination is in clear legal and factual error and should be withdrawn because the combination of McCanne and Westman fails to disclose each and every limitation of these claims as required for a proper rejection under 35 USC §103(a).

Referring to claim 1, Westman does not disclose or suggest an access controller provided in embodiments of the present application. As described below, Westman does not disclose controlling the resolving of domain name information for both server addresses within a network or accessible via said network and also server addresses that are not within a network or accessible via a network, as recited in claim 1. Instead, Westman relates to communications in which user equipment contains, or is provided with, a list of items of service-related information.

The list of service-related information represents a list of service provider names, services and/or service types. When intending to establish or modify a session or connection or use a service, the user equipment selects, in one of the embodiments, an item from the list and performs a DNS query to resolve the name of the selected item to an IP address which then is used for set-up. The list may be provided by a DHCP server or in a PDP context message. The list may include one or more service provider default names, in particular for visited and home networks. Nevertheless, in no way does Westman disclose controlling a resolution of domain name information for both server addresses within a network or accessible via said network and also server addresses that are not within a network or accessible via a network, as recited in claim 1.

For these and other reasons, the combination of McCanne and Westman does not disclose each and every limitation of the independent claims, such as claim 1. Claims 8-10, 15, 24, and 25 are similarly allowable over McCanne and Westman for at least the reason of depending from an allowable independent claims, and this rejection was maintained in the Advisory Action. Due to these clear legal and factual errors, this rejection should be withdrawn, and reconsideration and allowance of claims 8-10, 15, 24, and 25 are thus respectfully requested.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Notice of Appeal
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